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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,077

07/10/2003

José Luis Moctezuma de la Barrera

NAVI498

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51017 7590 02/01/2007  
INTEL. PROP./ RND  
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EXAMINER

JOHNSON III, HENRY M

ART UNIT

PAPER NUMBER

3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/617,077

Applicant(s)

MOCTEZUMA DE LA BARRERA ET AL.

Examiner

Henry M. Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 71-73, 75, 76, 78-80, 89-93, 95 and 97-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-73, 75, 76, 78-80, 89-93, 95 and 97-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>112006</u> | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 71-73, 76, 79-80, 89, 91-95, 99, 100 and 103 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication US 2001/0034530 to Malackowski et al. Malackowski et al. teach a surgical system that includes a handpiece (Fig. 1, # 102) referred to as a smart instrument and a surgical navigation system. The smart instrument may be any number of common surgical instruments that may be tracked by attachment to the universal tracker device (Fig. 3, # 200), including but not limited to a probe, scalpel, suction device, pin, or clamp. In order to couple the tracker device to the general instrument, an adapter is connected to the adapter interface of the universal tracker device and the general instrument is attached by a clamp screw (par 0070). This clearly teaches a removable tracking unit. The smart instrument may also store the specific geometry of the active part of the smart tool, i.e., the tip or the part of the tool that is in contact with the patient or delivering some kind of energy, mechanical, electrical, sonic, electromagnetic, etc. (paragraph 0080), thus teaching a unit that consumes power and in the case of mechanical energy, implies a bit or cutter that is interpreted as an accessory. Such cutters require a motor. The tracker device includes a plurality of infrared light emitting diodes, a communication transceiver

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(wireless receiver), and a status light. The battery of the tracker and the smart instruments is preferably a **common** lithium battery (paragraph 0069). It is inherent that a power connector be included. The smart instruments and the navigation system transceivers communicate via infrared (light energy) signals, although other types of wireless technologies may also be used (paragraph 0059). The properties of the smart instruments 102, such as geometry and functional features, are preferably graphically displayed on the computer monitor 108 to enable visual display of their spatial and functional relationships to other smart instruments, surgical equipment, and the surgical field (Figs. 25-32).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 90, 101 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2001/0034530 to Malackowski et al. Malackowski et al. are discussed above, but do not teach specific displays or a release button for detaching the

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tracking unit from the handpiece. Graphical displays are pervasive in the art including some with individual light elements such as LEDs or LCD displays. The selection of the display is considered a design consideration by a skilled artisan. The means for attaching the tracking unit to the handpiece or surgical instrument is likewise considered an obvious design consideration for one of skill in the art.

Claims 75, 78, 97 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2001/0034530 to Malackowski et al. as applied to claims 71 and 89 above and further in view of U.S. Patent Application Publication US 2002/0035321 to Bucholz et al. Malackowski et al. are discussed above, but do not teach a drill bit with coupling. Bucholz et al. disclose a system for use during a surgical procedure on a body. Using a navigation system (Fig. 11), the positioning of an instrument relative to a body can be displayed. One instrument that is used commonly is a drill. By placing emitters (tracking member) on a surgical drill (handpiece), and by having a fixed relationship between the drill body and its tip (usually a drill bit), the direction and position of the drill bit can be determined. The drill bit is interpreted as an accessory (and distal end) and such a bit inherently moves as it rotates and is coupled with a chuck (paragraph 0103). It would have been obvious to one skilled in the art to use the drill as taught by Bucholz et al. in the surgical device of Malackowski et al. as the use of such cutting instrument is well known and common in the art.

Claims 102 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2001/0034530 to Malackowski et al. as applied to claims 71 and 89 above and further in view of U.S. Patent 5,928,137 to Green in view of U.S. Patent 6,761,561 to Mandelkern et al. Malackowski et al. are discussed above, but do not teach a display mounted on the handpiece. Green teaches an endoscopic instrument with a flat panel

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display attached to the instrument provide a surgeon with a visual perspective similar to open surgery (abstract). Mandelkern et al. disclose the wireless transfer of data, specifically image data in a medical environment to eliminate the inconvenience of a cable (Col. 2, line 18). It would have been obvious to one skilled in the art to use wireless means for image transfer as taught by Mandelkern et al. to provide image data to an instrument mounted display as taught by Green in the invention of Malackowski et al. to reduce cable clutter in the area as suggested by Mandelkern et al. and to allow more natural line of sight operation of a surgeon as suggested by Green.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

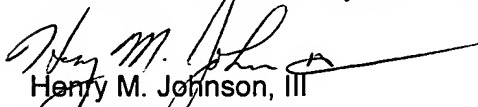
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Henry M. Johnson, III  
Primary Examiner  
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